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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,536	05/13/2005	Noriaki Minamida	L9289.04187	4469

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Washington, DC 20036

EXAMINER

LU, ZHIYU

ART UNIT	PAPER NUMBER
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2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/516,536

Applicant(s)

MINAMIDA ET. AL.

Examiner

Zhiyu Lu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 are rejected under 35 U.S.C. 102(e) as being anticipated by Kontio et al. (US Patent#6487410).

Regarding claim 1, Kontio et al. anticipate a mobile apparatus that performs radio communication by a cellular method, said mobile apparatus comprising:

an identification information storage section that stores identification information of a network provider providing a cellular radio communication service (column 4 lines 56-60);

a control section that extracts the identification information stored in the identification information storage section automatically or via manual user operation from the identification information storage section (column 4 lines 60-62);

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a transmitting/receiving section that transmits a signal containing the extracted identification information and receives a signal containing information on frequency and access technology that can be used at a current position of the mobile apparatus, extracted from an external database based on the transmitted identification information and transmitted to the mobile apparatus from a external source, by a communication method different from a cellular method (Fig. 5, column 4 line 13 to column 5 line 27); and

a frequency search section that carries out a frequency search when roaming is performed using the frequency and access technology that can be used according to the information received by said transmitting/receiving section (Fig. 5, column 4 line 13 to column 5 line 27).

Regarding claim 7, Kontio et al. anticipate a roaming method whereby a mobile apparatus that performs radio communication by a cellular method acquires information from a service information provision apparatus by a communication method different from said cellular method as explained in the response to claim 1 above.

Regarding claim 2, Kontio et al. anticipate the limitation of claim 1.

Kontio et al. also anticipate wherein the information received by the transmitting/receiving section also identifies a service that corresponds to the transmitted identification information and the mobile apparatus further comprises a service section that implements the identified service (inherent in dualmode terminal PP/MS, column 6 lines 52-67).

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Regarding claim 4, Kontio et al. anticipate the limitation of claim 1.

Kontio et al. also anticipate further comprising:

a database indicating correspondence between a network provider providing a radio communication service by said cellular method and a frequency and access technology that can be used (inherent in column 6 line 52 to column 7 line 7);

a receiving section, which has transmission output with an extremely limited range of reach of radio wave (DECT), that receives a signal containing identification information of said network provider transmitted from said mobile station (column 6 lines 22-35);

a control section that extracts the information on frequency and access technology that can be used corresponding to said network provider by searching said database using said identification information contained in the signal received by said receiving section (column 4 line 13 to column 5 line 27); and

a transmitting section that transmits a signal containing the extracted information on frequency and access technology to said mobile apparatus (column 4 line 13 to column 5 line 27).

Regarding claim 5, Kontio et al. anticipate the limitation of claim 4.

Kontio et al. also anticipate said database also includes correspondence between said network provider and a cellular radio communication service (column 4 line 13 to column 5 line 27);

said control section also extracts a cellular radio communication service related to said network provider by searching said database using said identification information

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contained in the signal received by said receiving section (column 4 line 13 to column 5 line 27); and

said transmitting section also transmits information indicating the extracted cellular radio communication service to said mobile apparatus (column 4 line 13 to column 5 line 27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kontio et al. (US Patent#6487410) in view of Kallio (US2002/0147008).

Regarding claims 3 and 6, Kontio et al. teach the limitations of claims 1 and 4.

But, Kontio et al. do not expressly disclose the communication method different from a cellular method is a wireless LAN or Bluetooth communication method.

Kallio teaches a dualmode mobile station configured to handover from a wireless LAN to a GSM network based on location update (paragraphs 0014-0015).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate using wireless LAN as the communication method other than cellular method taught by Kallio into the apparatus of Kontio et al., in order to provide convenient handover service in wireless LAN.

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Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zhiyu Lu whose telephone number is (571) 272-2837. The examiner can normally be reached on Weekdays: 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vuong Quochien can be reached on (571) 272-7902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

zh
Zhiyu Lu
December 17, 2006

Lane N. Le
12-19-06
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PRIMARY EXAMINER